

REMARKS

Status of the Claims

Claim 35 was previously withdrawn. Claims 2, 5, 14, 19, 21-22, 25-26, and 33 have been cancelled in the present amendment thereby leaving claims 1, 3-4, 6-13, 15-18, 20, 23-24, 27-32, and 34 pending. Each of these pending claims has been amended and following the issuance of the aforementioned *Advisory Action*.

The Applicants note that the *Advisory Action* was lacking with respect to the requirements of the Manual of Patent Examining Procedure § 707.07(f), which states that “an examiner must provide **clear explanations of all actions taken by the examiner** during prosecution of an application” (emphasis added). Specifically, the Applicants note that “[w]here the applicant traverses any rejection, the examiner *should*, if he or she repeats the rejection, **take note of the applicant’s argument and answer the substance of it.**” MPEP § 707.07(f) (emphasis added). While the *Advisory Action* is clear with respect to the nature of the rejections—anticipation under 35 U.S.C. § 102(e)—that action failed to address **any of the substantive arguments** advanced by the Applicants in their June 21, 2006 *Reply by Applicants to a Final Office Action (After Final Response)*, which was prepared at substantial cost to the assignee of the present application.

Notwithstanding, a representative of the Applicants further requested an interview with the Examiner as to obtain a better understanding of the specifics of the Examiner’s rejections as set forth in the *Advisory Action*. The Examiner declined the Applicant’s requests for a substantive discussion of the *Advisory Action* but did suggest that the Applicants narrow the claims with an aim toward achieving patentability.

The Applicants note that the Manual of Patent Examining Procedure § 713.09 (as it pertains to finally rejected applications) states that “[n]ormally, one interview after final rejection is permitted.” The Applicants appreciate that such an interview is optional and, further, that “[i]nterviews merely to restate arguments of record or to discuss new limitations which would requirement more than nominal reconsideration or

new search should be denied.” MPEP § 713.09. The Applicants note, however, that this request for an interview was not for the purpose of rehashing old arguments but to obtain a better understanding of the Examiner’s reiterated rejections with a greater level of detail as required by MPEP § 707.07. With that understanding, the Applicants may have been able to address particulars of the Examiner’s rejections with an aim toward speedy resolution of prosecution of the present application.

Notwithstanding, the Applicants appreciate the Examiner’s busy workload and have, albeit without guidance in light of the previously presented arguments, narrowed the claims as suggested by the Examiner during the aforementioned telephone exchange. The Applicants’ representative wishes to note that the undersigned can be made available at the convenience of the Examiner to discuss the amendment presented with the current *Request for Continued Examination* with the sincere hope of bringing this case to allowance and otherwise disposing of this application from the Examiner’s docket. In that regard, the Applicants believe the amendments presented herein clearly overcome the references of record and that allowance is in order as is set forth below.

Information Disclosure Statement

The Applicants submitted, in their June 21, 2006 *After Final Response*, an information disclosure statement compliant with 37 C.F.R. § 1.97. The Examiner reflected consideration of the same (with certain disclaimers) in the aforementioned *Advisory Action*. The Applicants thank the Examiner for consideration of said statement.

The Applicants note, however, that the Examiner did **not** indicate consideration of the reference identified as “Autonomy Technology White Paper.” As a copy of that reference has been previously provided on two occasions and the entry as to the Autonomy paper is compliant with Rule 97, the Applicants believe the lack of indication of consideration to be an accidental oversight and respectfully request an indication that the aforementioned reference has been properly considered.

Rejections under 35 U.S.C. § 101

In the Office Action dated April 21, 2006 (*Final Office Action*), the Examiner indicated that claims 1, 15, 18, 27, 30 and 33–34 were rejected under 35 U.S.C. § 101, “because the claimed invention is directed to non-statutory subject matter.” *Final Office Action*, 4, ¶ 7. The Examiner also rejected claims 3–14, 16–17, 20–21, 23–26, 28–29 and 31–32, depending from independent claims 1, 15, 18, 18, 27 and 30, respectively, on the same basis. The Applicants traversed the Examiner’s 35 U.S.C. § 101 rejection and evidenced that the claimed invention, as a whole, was useful and accomplished a practical application; that is, it produced a “useful, concrete and tangible result” as required by *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368, 1373–74 (Fed. Cir. 1998). See *After Final Response*, 11–13.

While the *Advisory Action* indicates that the application is “NOT . . . in condition for allowance,” there is no mention that said condition is predicated upon the aforementioned 35 U.S.C. § 101 rejection. *Advisory Action*; see also *Continuation Sheet* (making no reference to an outstanding rejection under 35 U.S.C. § 101 but only 35 U.S.C. § 102(e) in light of references to *Jacobi et al.*; *Adar et al.*; and *Boe et al.*). As such, the Applicants presume that the rejection has been overcome and withdrawn.

Rejections under 35 U.S.C. § 112, ¶ 2

The Examiner had previously rejected claim 27 “under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.” *Final Office Action*, 6, ¶ 9. The Applicants amended claim 27 such that the typographical error of ‘fro111’ was made to read ‘from.’ The Examiner’s *Advisory Action* indicates that this and the previously submitted amendments (which were generally cosmetic in nature) were entered. See *Advisory Action*. While the *Advisory Action* indicates that the application is “NOT . . . in condition for allowance,” there is no mention that such condition is predicated upon the

aforementioned 35 U.S.C. § 112 rejection. *Advisory Action*; see also *Continuation Sheet* (making no reference to an outstanding rejection under 35 U.S.C. § 112 but only 35 U.S.C. § 102(e) in light of references to Jacobi et al.; Adar et al.; and Boe et al.). As such, the Applicants presume that the rejection has been overcome and withdrawn.

Rejections under 35 U.S.C. § 102(e) per Jacobi

The Examiner's *Advisory Action* indicates that claims 1–26 “are rejected under 35 U.S.C. § 102(e) as being anticipated by Jacobi et al [hereinafter *Jacobi*], US Patent No. 6317722.” *Advisory Action*, Continuation Sheet. The Applicants note that claims 2, 5, 14, 19, 21, 22, 25-26 are cancelled and thus the rejection of these claims is moot. The Applicants have amended independent claims 1, 15, and 18.

Claim 1 now recites:

A computer-implemented method for creating a personalized **display of electronic-mail documents** for a user, comprising the steps of:

creating a database entry in a database, the entry including a user ID for each user of a client document server, **wherein the client document server is coupled to an electronic-mail client;**

tracking requests by the user for access to at least one document on the client document server, wherein the requests are tracked using a tracking module;

storing, in the database, information regarding each document requested by the user, **the information regarding each document comprising information obtained from textual analysis of each of the requested documents;**

analyzing the stored information **including the information obtained from textual analysis of each document requested by the user** to construct a profile of the user, wherein the profile of the user is associated with the user ID;

determining interests of the user based on at least the user profile, the determination being made by at least one recommendation software application; and

providing the user with electronic mail notifications comprising recommendation information with regard to viewing additional documents on the client document server, wherein the recommendation information notifications are generated based upon at least the determined interests of the user.

Jacobi fails to disclose, at least, (1) the personalized display of electronic-mail documents; (2) the document server being coupled to an electronic-mail client; (3) textual analysis of requested documents, information derived from that textual analysis being stored in a database; and (4) analyzing the information, including the textual analysis information, with respect to constructing a user profile. As “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the Applicants contend that *Jacobi* fails to anticipate the invention as set forth in claim 1 of the application. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added).

Further—and as addressed in the Applicants’ *After Final Response*—*Jacobi* does not disclose ‘tracking requests by the user for access to at least one document on the client document server.’ *Jacobi*, as cited by the Examiner, concerns **items of known interest in a shopping cart**. See *Jacobi*, col. 3, l. 43-48. The items in the shopping cart may be used to generate recommendations when the shopping cart is viewed. *Id.*

An item of known interest in *Jacobi* does not constitute the presently claimed ‘document’ as is recited in claim 1. As is reflected by the preamble, that document is an ‘electronic-mail document.’ See *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (finding that “a claim preamble has the import that the claim as a whole suggests for it”); see also *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (holding that “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim . . . then the claim preamble should be construed as if in the balance of the claim”).

The specification of the present application supports this amendment in that “[i]n an e-mail embodiment, the document can be an e-mail message or listing of messages, such as an in-box.” *Specification*, p. 9 at l. 9-11. There is no suggestion in *Jacobi* with respect to equating ‘items of known interest’ in a ‘shopping cart’ with e-mail documents on a document server. *Jacobi* also fails to disclose the aforementioned coupling of the document server to an e-mail client. As noted in the specification, “in

alternative embodiments, the present invention is implemented with a client e-mail . . . system." *Specification*, p. 13, l. 12-13.

Jacobi further fails to disclose textual analysis of requested documents, wherein the information derived from that textual analysis is stored in a database. The Examiner previously referenced — with regard to the previously presented storage element — that portion of *Jacobi* that discussed "types of information" that may be stored, including "the user's purchase history"; "the user's item rating profile"; "the current contents of the user's personal shopping cart"; "a listing of items that were recently . . . removed from the shopping cart(s) without being purchased." *Jacobi*, col. 7, l. 51-58. Not only does this portion of *Jacobi* fail to disclose information about a requested document, it specifically fails to disclose information derived as a result of textual analysis of the requested document.

As *Jacobi* fails to disclose the textual analysis of a requested document, it logically follows that *Jacobi* cannot disclose the recited element of analyzing the information, including the textual analysis information with respect to constructing a user profile. The Examiner has previously argued that *Jacobi* discloses analyzing information to create a profile. See *Final Office Action*, 8 at ¶ 11. While *Jacobi* discloses a user profile, there is no indication as to how that profile is generated. Specifically, there is no indication of stored information being analyzed to create that profile as is a part of claim 1. Further, there is no disclosure as to analysis of information derived from the aforementioned textual analysis in creating that profile. The Examiner's previous citation to *Jacobi* at col. 7, l. 59-64 and col. 10, l. 46-51 both concern contents of the aforementioned shopping cart. As has been previously evidenced, shopping cart contents cannot be earnestly argued to constitute the invention (as set forth in claim 1) with respect to electronic-mail documents and textual analysis of the same.

For example, in one exemplary implementation of claim 1, a document server may be an enterprise mail server. Electronic mail messages may arrive at that server from various senders. Some of those sender's may be friendly, others may not. In the latter category, unfriendly or unwanted e-mail (e.g., spam) is often generated by various

individuals and or enterprises. Review of 'spam' can be time consuming and, in some instances, even dangerous as opening a message from an illicit sender may release an unwanted virus, spyware, or other malware into a computer network. There is, therefore, a need to avoid the display of unwanted electronic mail to a user for both the sake of time and network security.

The present invention, as set forth in claim 1 for example, provides a solution to this need. As a user accesses certain electronic-mail documents—presumably e-mail documents from *friendly* or *approved* senders—information about those accessed e-mails is tracked; specifically, information concerning a textual analysis of those e-mails. Textual analysis may identify, for example, the subject of the message; the sender of the message; or other information that may be derived from the message. That information is stored in a database and associated with the user ID. For example, if a user opens an email from a co-worker, textual analysis may identify the fact that the e-mail was sent from an address of a particular domain (*e.g.*, *colleague@work.com*) or that certain keywords were identified in the message body (*e.g.*, company name, project names, names of co-workers, etc).

That information derived from textual analysis is stored and may later be analyzed to determine that future message documents containing these words or other textual identifiers are preferred or welcomed by the particular user. That is, the user is interested in receiving messages that correspond to this information as are identified over time based on the development of a user profile. Thus, the user may be informed at later dates whether subsequently arriving documents (*e.g.*, new e-mail messages) are worth viewing.

For example, if a user receives a future message from that same co-worker with the aforementioned domain name or address, the user may be informed of its receipt through its display to the user (*e.g.*, 'you have new mail'). Similarly, a later arriving message may not conform to the user profile (*i.e.*, the message may be spam in that it does not correspond to an 'interest' of the user). In this instance, the user may be provided an e-mail notification that the message has arrived but that it is not necessarily

one that the user wants to view (e.g., 'you have spam'). Through this recommendation information (e.g., this message does not comply with your interests, you may not want to open it), the message is not erroneously opened, which could result in the release of a virus into the network.

Jacobi discloses no teachings even remotely associated to the presently claimed subject matter of claim 1. As such, the Examiner's rejection under 35 U.S.C. § 102(e) in light of *Jacobi* is believed to have been overcome. Independent claims 15 and 18 recite similar limitations as those found in claim 1 and are, therefore, allowable for at least the same reasons as claim 1. Any claims depending from claims 1, 15, and 18—either directly or via another dependent claim—are also allowable for at least the same reasons as their respective base claim as provided for by 35 U.S.C. § 112, ¶ 4.

Rejections under 35 U.S.C. § 102(e) per Adar

The Examiner rejected claims 27–32 and 34, “under 35 U.S.C. § 102(e) as being anticipated by Adar et al. [hereinafter *Adar*], US Patent No. 6493702.” *Advisory Action*. The Applicants respectfully traverse the Examiner's 35 U.S.C. § 102(e) rejection as set forth below.

Independent claim 27, as amended, recites:

A method of using a computer to customize **electronic-mail document information** provided to a user over an electronic network, comprising the steps of:
tracking requests by a user of a client document server for at least a first requested document on the client document server, **wherein the client document server is coupled to an electronic-mail client;**
extracting filtered content from the at least first requested document;
analyzing the filtered content of the at least first requested document;
constructing a profile of the user from the analyzed content;
determining, based on the user profile, the interests of the user; and
providing the user with recommended information by email based upon the determined interests of the user **as the determined interests of the user pertain to additional documents to be viewed by the user.**

Claim 27, like claims 1, 15, and 18, above, discloses a method concerning electronic-mail document information. There is no such disclosure in *Adar*. *Adar* is concerned exclusively with “information derived from shared document bookmarks, to augment Internet searches, re-rank search results, and provide recommendations for documents based on a subject-matter query.” *Adar*, Abstract. There is absolutely no discussion of electronic-mail document management, filtering such an electronic-mail document and providing recommendations to a user as to whether or not to access additional electronic mail-documents based on a profile developed through analysis and filtering of previously viewed electronic mail documents. Claims 30 and 34 as well as any claim dependent from claims 27, 30, and 34 are allowable for at least the same reasons.

Rejections under 35 U.S.C. § 102(e) per Boe

The Examiner rejected claim 33 “under 35 U.S.C. § 102(e) as being anticipated by Boe et al [hereinafter *Boe*], US Patent No. 6236975.” *Advisory Action*. Claim 33 has been cancelled thereby making the Examiner’s rejection moot.

CONCLUSION

The Applicants believe the Examiner's rejections of the presently presented claims to have been overcome. None of the references of record—especially *Jacobi*—disclose, at the least, (1) the personalized display of electronic-mail documents; (2) the document server being coupled to an electronic-mail client; (3) textual analysis of requested documents, information derived from that textual analysis being stored in a database; and (4) analyzing the information, including the textual analysis information, with respect to constructing a user profile. Claims 1, 15, and 18 (and their dependencies) are overcome for at least this reason. The remaining independent claims (and their respective dependencies) are also allowable in that the references of record fail to disclose any aspect of e-mail document management. As such, the present application is believed to be in condition for allowance.

If the Examiner has any questions, the Applicants again welcome the Examiner to contact the undersigned.

Respectfully submitted,
Jonathan Oliver et al.

August 24, 2006

By: Kenneth M. Kaslow
Kenneth M. Kaslow (Reg. No. 32,246)
Carr & Ferrell LLP
2200 Geng Road
Palo Alto, CA 94303
Tel: (650) 812-3400
Fax: (650) 812-3444